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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,462	11/28/2003	Chikai Yoshimizu	1297.43308X00	7995
20457	7590	02/08/2006	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			LOPEZ, MICHELLE	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/722,462

Applicant(s)

YOSHIMIZU ET AL.

Examiner

Michelle Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 25-35 is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-14, 16-24 is/are rejected.
- 7) ☐ Claim(s) 9 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of claims 1-24 in the reply filed on July 26, 2005 is acknowledged.
2. Claims 25-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 26, 2005.

### *Priority*

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been received.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6, 10-11, 16-17, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the scope of the claim is not clear in that the claim recites a cover for use with a portable tool, yet further claim details of the portable tool being used. Therefore, it is unclear as to whether applicant is claiming a combination of a cover and the portable tool being used with the cover or just the cover. If applicant is claiming the combination, then the preamble should so state.

Claims 4, 10, and 16 recite the limitation "its front end". Also, claim 21 recites the limitation "the information". There is insufficient antecedent basis for these limitations in the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Swierczek (5,024,014).

Swierczek discloses a cover 20 being made from a light transmissive material and removable disposed to an outer frame for protectingly covering an entirety of a label 23 and at least a part of the outer frame.

With respect to claim 2, Swierczek teaches wherein the cover 20 is made from a transparent material (as shown in the Figs.) and a translucent resin, e.g. plastic.

With respect to claim 6, Swierczek discloses wherein the label 23 contains an information.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-2 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Pia et al (6,615,518).

Pia discloses a cover 101 being made from a light transmissive material and removable disposed to an outer frame for protectingly covering an entirety of a label 102 and at least a part of the outer frame as shown in col. 2; 4-9.

With respect to claim 2, Pia teaches wherein the cover 101 is made from a transparent material and a translucent resin.

With respect to claim 6, Pia discloses wherein the label 101 contains an information.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4, 6-8,10, 12-14, and 16, 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (5,025,970) in view of Pia (6,615,518).

With respect to claims 1, 7, 13, Anderson discloses a cover 22 being made from a resilient polymeric material and a portable tool including a power section, a mechanical section driven by the power section, wherein the cover is removably disposed to an outer frame of the tool for protectingly covering at least a part of the outer frame, but does not disclose a label wherein the cover covering an entirety of a label.

However, Pia teaches the concept of a cover for use with a label and a tool, wherein the cover covering at least an entirety part of the label for the purpose of providing an identification label retaining and displaying zone wherein information of a tool owner is displayed. Therefore, Pia teaches the concept of a cover for use with a label and a tool, and its specific placement would be obvious to one having ordinary skill in the art to have provided Anderson's invention with a label in order to provide an identification means wherein information of a tool owner is displayed.

With respect to claims 2, 8, and 14 Anderson teaches wherein the cover is made from a transparent resin.

With respect to claims 4, 10, and 16, Anderson teaches wherein the outer frame has a front tapered section with a diameter gradually reduced toward end front end and wherein the cover has a hollow cylindrical shape in conformance with an outer profile of the front tapered section, the cover having an inner peripheral surface in contact with a part of the tapered section and fitted to the front tapered section, but does not disclose wherein the cover inner peripheral surface is in contact with the label. However, Pia also teaches wherein a cover inner peripheral section is in contact with a label 102 as shown in Fig. 30.

With respect to claims 6 and 12, Pia also teaches wherein the label contains an information.

With respect to claims 18-22 and 24, Pia teaches wherein the label is made from paper, e.g. a tag (claim 18). Pia also teaches wherein it is old and well-known in the art to provide a label having an adhesive surface in contact with an outer surface of the tool (claim 19) and wherein the label is one of a plurality of labels those printed on a single sheet (claim 20) as shown in col. 1; 51-65; wherein the information is the name of the user as shown in col. 2; 4-8 (claims 21 and 24) and the label is printed as on basis of data employed by the user as shown in col. 2; 28-31 (claim 22).

With respect to claim 23, Anderson as modified by Pia does not disclose wherein the data is distributed by way of one of internet and a recording medium. However, it would have been an obvious matter of design choice to have provided a data distributed by internet or a recording medium, since applicant has not disclosed that such data distribution solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with

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Pia's label being printed and identified by the user of the tool for the purpose of enabling the user to identify and personalize its tool and distinguish its among others tool.

7. Claims 5, 11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (5,025,970) in view of Pia (6,615,518), and further in view of Hiatt.

Anderson as modified by Pia teaches the invention substantially as claimed, except for a cap. However, Hiatt shows a portable tool with a label 12', a front tapered section having a front end at 10, and a cap 7 positioned at the front tapered section for the purpose of forming a tight locking friction fit between the front tapered section and a cover 2, therefore preventing the label from being displaced relative to the front tapered section. In view of Hiatt, it would have been obvious to one having ordinary skill in the art to have provided Anderson's invention as modified by Pia, and further with a cap positioned at a front tapered section in order to form a tight locking friction fit between the front tapered section and a cover.

#### Allowable Subject Matter

8. Claims 3, 9, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Noll'247, Anderson'970, Hiatt'253, and Huang'600 are cited to show related inventions.



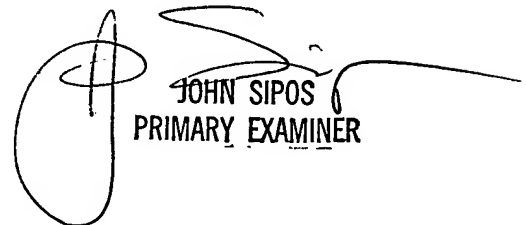
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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JOHN SIPOS  
PRIMARY EXAMINER